

## **REMARKS**

### **1. Title and Abstract**

The Title and the Abstract were amended in the previous response to the Final office action. A review of the PAIR site "Transaction History" suggests that the Title has not yet been amended, however the "File Wrapper Images" illustrates its entry on the file. In the current office action, there is no acknowledgement of the amended title nor the replacement abstract. Please advise if the Applicant would need to enter a second request for amendment.

### **2. Further Amendment to Claim 3**

A Request for Continued Examination (RCE) was filed as the Examiner believed the June 24, 2005 response raised new issues.

The June 24, 2005 response amended independent claim 3 to clarify:

- that any user fees that are paid are insufficient to assure continued availability of the archived IP;
- that the endowment is associated with the archived IP; and
- that the endowment fund generates enduring funding to assure continued availability of the archived IP.

At page 15 of the office action, Examiner acknowledges consideration of the Applicant's previous June 24, 2005 amendments and arguments and in response raises an additional reference by Hsiao for the principle of an endowment and thereby, in the Examiner's opinion, rendering claim 3 as unpatentable over Watanabe et al. in view of Wilkinson and the new reference Hsiao.

This response amends independent claim 3 to clarify:

- that the endowment fund is associated with each archived IP.

### **3. Response to Claim Rejections**

To facilitate reference to the prior art cited by the Examiner, specific passages referenced by the Examiner are excerpted and presented in Appendix A.

Further, and while not intended to be limiting, convenient reference to Applicant's specification on file is provided by excerpts presented in Appendix B.

Applicant will address the Examiner's claim rejections in the following sequence:

A. Misinterpretation of the cited prior art in the Examiner's in assessment and rejection of features of the invention as claimed in dependent Claims 20, 24 and 31, those misinterpretations being symptomatic of a fundamental misunderstanding of the teachings of those references applied to independent claim 3; and

B. Claim 3, the only Independent Claim

- (i) Misinterpretation of the claimed feature "user fees" in cited Wilkinson reference;
- (ii) Misinterpretation of the claimed feature "endowment fund" in cited Wilkinson reference; and
- (iii) Misinterpretation of the claimed feature "endowment fund" in cited Hsiao reference.

**A. Claims 20, 24, 25 and 31- Rejection under 35 USC 103(a) – Obviousness**

Claim 20:

At page 7 of the office action, the Examiner combines Watanabe for "managing the PIPD by operator-managers" and Wilkinson for "charging user listing or transactions fee for establishing the endowment trust fund" as the basis

for teaching applicant's separation of the management of the endowment separately from the management of the IP.

Applicant claims: "managing the PIPD by operator-managers; and separately managing the endowment trust from the management of the PIPD".

The Applicant disagrees with the Examiner's assertion that such separation 'by function' is obvious, as stated by the Examiner, "since the management of fund is financial in nature and IP management deals with intellectual property". Neither Watanabe nor Wilkinson has both finances and property to manage. Wilkinson does not teach an endowment fund which is relied on to fund access to property into perpetuity. As there is no need to perpetuate the storage and access to property, there is no recognition, incentive or motivation in Wilkinson to safeguard the fund separate from management of the access and storage of the property.

The Applicant submits that the separation taught here is not by function, as the examiner contended. It is instead 'by mandate', quite similar to the separation of the management of General Motor's pension fund from the management of its general operations. Since the management of general operations must include, amongst other components, astute financial management, it is clear that management that is functionally 'financial in nature' is required by both the pension fund and the general operations. The separation of the these two managements is mandated by the objective of sustained financial longevity of the pension fund independent of the general operations. The advent of this kind of organizational, mandate-driven separation, instead of functional separation, of pension funds from general operations has dramatically benefited the employees of business corporations by shielding them from misdeeds and/or misjudgments of the managers of the general operations.

Applicant teaches in this application the until-now unlikely use of such organizational, mandate-driven separation to the problem of financial longevity of the archival of IP. The Applicant submits that such separation has never been practiced by any operators of any IP archival operation, and object to the Examiner's mis-categorization of the separation and the Examiner's casual

conclusory statement used in the rejection without citing any appropriate prior art or general knowledge to those in the art..

Claims 24 and 25:

At page 9 of the office action, the Examiner cites Watanabe as teaching "one or more access files, separate from the archived IP" as claimed. The Applicant claims: "establishing one or more access files separate from the archived IP, each access file associated with a user;" The key feature here is 'separate from the archived IP'.

At the cited locations of Figs. 6-7B and Col. 6, lines 39-67, Watanabe teaches the use of a display screen and input form for the user to enter information related to the IP, but does not establish or create a separate access file. Watanabe's screen information is not associated with a user, but is accessible and editable by any user. In contrast, Applicant creates a separate access file that is specific to the user, that can contain annotations and comments and can be stored either on the user's system or on the archival system and, as claimed in claim 25, when opened, will apply the annotation to the retrieved IP before presenting the combined product to the user.

A person of ordinary skill would not find the conventional annotation of archived information via display screen and input forms relevant in the claimed establishing of separate access files for each user and containing information added by the user and further which is combinable on viewing with the archived IP. Watanabe is therefore not applicable prior art.

Claim 31:

The Examiner directs us to an IP Index. The IP Index that the examiner refers to in Wilkinson [0035] teaches "gathering data and computing an IP Index, or indices" of IP Assets. The teaching clearly refers to 'numerical index or indices' such as Dow Jones Industrial Index, NASDAQ index and NYSE index that needs to be data gathered and computed, and is used to track investment performance

or compare or select investments. It has been cited out of context by the examiner as prior art to the Applicant's 'index tag' containing information such as Permanent IP Address that will facilitate location and retrieval of the archived IP. Wilkinson is therefore not applicable prior art.

A person of ordinary skill in the art would not find stock exchange indices relevant in the archival of IP. Wilkinson is therefore not prior art.

#### **B. Claim 3 - Rejection under 35 USC 103(a) – Obviousness**

At pages 2 – 5 and page 15, the Examiner has maintained the previous rejection of claim 3 as being obvious over Watanabe et al. (US 6,157,947, hereafter "Watanabe") in view of Wilkinson (US 2001/0034695, hereafter Wilkinson), and Hsiao (ACM SIGMOD Record).

#### **Amended Claim 3**

Amended claim 3 clarifies that an **endowment fund** is established and is associated **with each archived IP**. The endowment fund is a financial element **distinct from the user fees** which are more clearly defined as being insufficient to **assure continued availability of the archived IP**. In short, user fees are different from, and have a different purpose from, the financial support provided under the endowment fund or funds associated with each archived IP.

#### **Examiner's Response to Arguments for Claim 3**

##### **Watanabe**

Examiner cites Watanabe for teaching providing an information storage and retrieval archival system containing plural archived intellectual property (IP).

The Examiner concurs (at page 3), that Watanabe does not teach, nor contemplate:

- user fees; or
- an endowment fund.

**Wilkinson**

Examiner maintains the citation of Wilkinson for teaching a user fee based access to the archived IP through an electronic communications network. Applicant disagrees.

At page 3, the Examiner's reference to [0023] only identifies transaction fees "to fund the regulatory process". The Examiner appears to have adopted an "obvious to try" approach to combining references. This is an improper application of the obviousness analysis. This ignores 'problem recognition' as an element of an obviousness rejection. There is no suggestion that fees to fund a regulatory process any way suggest that fees might be charged to access archived and the Applicant's claimed problem and solution that user fees to access archived IP can be insufficient to ensure that the archived IP remains accessible into perpetuity.

Thus, in Wilkinson, there is no teaching, suggestion or motivation shown for

- fees for accessing archived IP;
- access to archived IP; and
- system to archive IP at all.

Reviewing Wilkinson in more detail, and illustrative of Wilkinson's lack of concern and lack of motivation to archive IP, Wilkinson provides examples of IP assets (at [0004]) which include databases and trade secrets which are particularly volatile. Financial instruments, which may be bought and sold, are developed to assign value to all assets including IP Assets. While the financial instrument for the respective database or trade secret may be valuable, there is no mechanism disclosed to archive the actual IP Asset. In contrast, one foundation of Applicant's invention is that IP is archived, that the archived IP is available and that the availability is enduring.

Information embodied in such databases and in trade secrets changes over time, is easily lost and is often lost, causing changes in and at

times total loss of the financial value of such IP asset. Wilkinson is unconcerned about any impairment or loss of the IP and would merely ask "what is the effect of such an event on its value?" Wilkinson has no interest in, and does not teach, prevention of the loss of an IP Asset.

Thus Wilkinson does not teach, nor contemplate:

- archival of IP; or
- assuring continued availability of said archived IP.

In the U.S.C. 103 (a) rejection, the examiner relied heavily on Wilkinson paragraph [0025] on page 3:

'Thus, the valuation method of using IP market may comprise computing the value in part or in whole of any business entity for any purpose by taking into account the tangible market value of IP assets. *A business entity* may be any business organization or part thereof, such as a partnership, fund, corporation, *trust, foundation, endowment*, sole proprietorship, association, and the like. The purpose of determining the value may include for use as a basis for any financial transaction or for any business or financial purpose, including, for taxation, preparation of financial statements, debt/equity transactions, purchases, sales, loans, collateral, donations, exchanges, investing, trading, mergers, acquisitions, spin-offs, liquidation, buybacks, leveraged buyouts, stock/debt exchanges, hedge funds, and the like. The IP exchange value may also be used to determine the value of organizations with business assets for the purpose of reorganization, refinancing, liquidation, and the like during bankruptcy proceedings.' *{Applicant's italics}*

As set forth in the identified passage, Wilkinson's teaching relates to

- financial instruments based on IP;
- methods of determining the valuation for IP owned by business entities; and
- an exchange market for such financial instrument.

In [0025] excerpted above, Wilkinson identified various business entities, including 'trust, foundation, endowment' that may own IP assets with market value. He then further suggested various business and financial purposes for the determined value.

Wilkinson makes no mention, indicates no interest, demonstrates no skill in the arts and provides no teaching on the matters of Applicant's teachings including:

- any means for the accessibility of the actual IP owned by such business entity;
- the archival of such IP;
- the long term financial viability of such archival; and
- the use of endowment fund to ensure long term financial viability of IP archive.

The Examiner incorrectly construed the coincident occurrence of the words 'endowment', 'trust' and 'IP' by Wilkinson in [0025].

As stated earlier, Wilkinson's context of endowment and trusts is for business entities trading financial instruments. Wilkinson's context for IP is as an asset having a value. The Examiner further extrapolated this incorrect construction as support that Wilkinson teaches in this passage that the use of an endowment fund, which is not taught in Wilkinson, to ensure financial longevity of an IP archive. Wilkinson [0025] is therefore not applicable prior art.

Contrary to the Examiner's assertion, at the middle of page 3 of the office action, that Wilkinson teaches "to hold the intellectual property", there is no suggestion of archival of the underlying IP; of access provided to archived IP; and of fees for accessing archived IP.

Thus Wilkinson does not teach, nor contemplate:

- enabling access to archived IP;
- enabling electronic access by users to the archived IP on an electronic network;



- maintenance and operation of a storage and retrieval system.
- a user-fee based access to the archived IP;
- the insufficiency of user fees alone to provided for continued availability of said archived IP; nor
- the need for an endowment fund earmarked for each archived IP for the enduring archival of said archived IP.

Each of the teachings of Watanabe and Wilkinson are deficient to produce the claimed invention.

Neither the combination nor modification of the teachings of the prior art produce the claimed invention. Firstly, there is no teaching, suggestion or motivation to combine or modify the teaching in either the references themselves or in the knowledge generally available to one of ordinary skill in the art. Secondly, lacking a suggestion or motivation to combine or modify the references, even if hypothetically the references had some relevant teachings at all, that hypothetical combination is not sufficient by itself to establish prima facie obviousness without some motivation.

The Examiner suggests that the combined teaching of Wilkinson's fee system and Watanabe's archival system teaches all of Applicant's invention except the endowment being associated with archived IP. As described above, Wilkinson fees specifically fund a regulatory process (see [0023] and Examiner's statement bottom of the second full paragraph on page 3) and there is no suggestion in Wilkinson or Watanabe that fees could or would ever be used to maintain and archive an IP database and further it is never suggested that any fees would, in the Examiner's words, "guarantee continual growth for more users to access and share."

Hence, Wilkinson is not, and cannot be, a user-fee based archival system, does not archive IP, does not fund the preservation of IP for continuing

availability and thus does not provide the missing elements of Watanabe and cannot be properly combined in an obviousness rejection.

Wilkinson does not provide the missing elements of Watanabe and thus cannot be combined. There is no suggestion or motivation to modify Wilkinson to apply the teachings therein to archived IP, nor to the continued availability thereof.

### **Hsiao**

At page 4, the Examiner introduces Hsiao as teaching the formation of "an endowment for the promotion of international exchange on database research and development including sponsoring future VLDB conferences".

At page 4, the Examiner's reference to Hsiao pages -11- and -13- refers only to the failed attempt of the author to assist subsequent VLDB conferences. If there was an endowment, it failed on several counts: one, it failed to provide for subsequent conferences (6<sup>th</sup> and 7<sup>th</sup> were otherwise funded) and secondly, the funding was only to provide seed money to promote or initiate a conference but the conference had to make a profit to continue.

The Hsiao reference completely fails to satisfy the endowment feature of Applicant's claimed invention. As set forth in Hsiao at page -11-, the so-called "VLDB Endowment" was established for the promotion of conferences. At pages -9- and -11- the \$7500 "seed" money was contributed to the fund. At page -10-, the "seed" money was exhausted in the 3<sup>rd</sup> and 4<sup>th</sup> VLDB Conference. Further, on page -11- and -12- a decision was made not to support one conference from the endowment and on page -12- that the author decided to sponsor the conference after all. Arbitrary discretion to fund or not is NOT a characteristic of the endowment of Applicant's invention. The continued availability of archive IP cannot be dependent on the whims of the "endowment". The 'Hsiao endowment' does not even fit the incomplete definition of an endowment as set forth by the Examiner at the top of page 4 of the office action, in which an endowment provides for the continuing support or maintenance of the operation during the insufficiency of user fees.

The Hsiao endowment does not assure that a conference will be held at all. Further on page -11-, a committee discusses if a particular conference should be held and who might participate in the sponsorship. The uncertainty about "if" and "who" might fund is in complete opposition to Applicant's invention.

Further, Hsiao cannot be modified to include the objectives of Applicant's claimed invention as there is no preservation of anything at all and certainly not any archived IP. Hsiao's fund sponsors events but is associated with meetings of people and the presentations of papers which does not suggest that any of the outcome would be preserved or maintained into perpetuity. A conference may or may not be funded. There is not even a suggestion that a conference contributor might provide a sufficient endowment amount to fund conferences into perpetuity. The Hsiao fund provides seed money only to promote conferences and the conference itself must generate a profit to survive another year.

Even if the fund were to fund conferences into perpetuity, which it does not, there is no mention of the fate of any IP generated therefrom.

Furthermore, other than describing the goals of the VLDB endowment, Hsiao provided no teaching as to the establishment and management of such endowment, for example how the amount of the required endowment will be determined, such as by a preferred use of an actuarial assessment, and how the management of such endowment will be kept separate by mandate from the archive's general operations, both aspects being amongst the features of Applicant's teaching.

Thus, regarding the endowment element, Hsiao does not teach, suggest nor contemplate:

- that an endowment would fund any archival into perpetuity;
- that the endowment fund would be associated with archived IP, or archived "anything" for that matter;

- that the endowment must generate enduring funding for the maintenance and operation of a storage and retrieval archival system so as to assure continued availability of the archived IP. Hsiao does not contemplate the continuance of anything except the promotion of something that may or may not transpire.

Thus, Hsiao does not provide the elements missing in Watanabe and Wilkinson and one of ordinary skill would not be able, through any one or a combination of the three references, to conjure up an archiving of IP wherein there is an endowment associated with each archived IP so as to ensure its continued availability whether or not it was ever accessed and whether or not any user fees were ever paid.

The following is a list of questions that illustrate the deficiencies in the Examiner's citations of Watanabe, Wilkinson and Hsiao, in relations to key features of Applicant's teachings:

- Do any of the three references consider user fee access to archived IP? No.
- Does the only reference to archived materials, Watanabe, suggest users should pay a fee to access Watanabe's archived semiconductor materials? No.
- Does Watanabe suggest that archived IP would benefit from some form of enduring protection? No.
- Does Wilkinson archive any IP? No.
- Does Wilkinson suggest archiving fees as a solution for stored materials such as Watanabe's materials? No.
- Do Wilkinson's fees, for funding a marketplace for IP, provide a solution to a person in the art of archiving IP for access by users? No.

- Does Wilkinson suggest that fees should be charged to access archived IP where Wilkinson has not even contemplated archival of IP which would serve no purpose in Wilkinson's marketplace? No.
- Does any combination of the three references suggest that continued access to archived IP, or archived anything, be funded from an endowment sufficient to generate enduring funding ? No.

Wilkinson is merely satisfied to assess a value of an IP Asset but Wilkinson's disclosure neither influences whether it is archived nor preserved. Hsiao is suggesting that an endowment of seed money be formed for promoting conferences, and which itself is insufficient to fund a conference, and Hsiao does not contemplate the assurance of any particular matter, the least of which is archiving of any IP.

#### **4. Checklist against MPEP guidelines**

The Applicant submits that when checked against the Manual of Patent Examinations Procedure (MPEP), the Examiner's U.S.C. 103 (a) rejections addressed above did not meet many of the stipulated requirements for rejection. These deficiencies are summarized herein below:

##### **1. MPEP 2143.03:**

***All Claim Limitations Must Be Taught or Suggested:***  
*To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). {MPEP pg. 2100-133}*

- In the table below, claim limitations of Applicant's Claim #3 are checked against teachings of Watanabe, Wilkinson and Hsiao. This table clearly demonstrates that not all Applicant's claim limitations have been taught by these cited prior arts.

<b>Claim 3</b>	<b>Watanabe</b>	<b>Wilkinson</b>	<b>Hsiao</b>
A technical and commercial method of managing information comprising the steps of:	NO Technical, not commercial	NO	NO Commercial, not technical
providing an information storage and retrieval archival system containing plural archived intellectual property (IP);	YES	NO	NO Sponsoring conferences, not archival
enabling a user fee based access to the archived IP in the information storage and retrieval system by users through an electronic communications network, the user fees being insufficient to assure continued availability of the archived IP in the information storage and retrieval archival system; and	NO  No user fees at all	NO No user fees at all Traded as a commodity If a traded IP Asset loses value it is traded	NO No access to archived IP Fees for users of the Conference YES. Fees sufficient to assure continued availability? NO
establishing an endowment fund	NO	NO Any business endowment can buy, sell or discard an IP Asset at a whim - not for enduring preservation of an IP	NO A fund? for an activity but not for an IP. Each activity or conference petitions the fund for support - which can be denied - hardly enduring
associated with each archived IP,	NO	NO Not interested in the health or accessibility of underlying IP, just its valuation.	NO Associated with a conference generally, not an IP. Applied to an event not to o presentations or IP presented at such a conference
said endowment trust being managed separately from the user fee based access, the endowment fund generating enduring funding for the maintenance and operation of the storage and retrieval archival system to assure continued availability of the archived IP regardless whether there is user fee based access thereto.	NO  No user fee or endowment	NO  No user fee or endowment	NO  The funding does not assure continued availability Does not teach how endowment fund is funded or managed.

**2. MPEP 2143.01:**

*Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.*

*"The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). {MPEP pg. 2100-130}*

Regardless of the chance appearance of the word "Trust" or "endowment" as a form of business entity in Wilkinson, there is not a single instance in Watanabe, Wilkinson or Hsiao that refers to a sum of money invested in the financial preservation of archived IP.

None of the cited references 'teaches, suggests or shows motivation' to establish an endowment fund associated with each archived IP to assure its permanence in the archival system. Neither had the examiner provided any applicable reference of the *knowledge generally available to one of ordinary skill in the art* in which such teaching, suggestion or motivation is found. Thus, none of these can be combined with the others to render the claimed invention obvious.

**3. MPEP 2143.01:**

*FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS*

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

*In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)  
{MPEP pg. 1200-131}

None of the cited prior art teach, suggest or show *motivation* for the desirability of the combination.

**4. MPEP 2143.01:**

*FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS*

*A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). {MPEP pg.2100-131}*

The examiner has not produced references of general knowledge of one of ordinary skill in the art that individually teach aspects of the applicant's claimed invention. Even if he had, the examiner still failed to offer any *objective reasons* to combine the teaching of the references to produce all aspects of the applicant's teaching.

**5. MPEP 2141.01, III:**

*CONTENT OF THE PRIOR ART IS DETERMINED AT THE TIME OF THE INVENTION WAS MADE TO AVOID HINDSIGHT*

*The requirement "at the time the invention was made" is to avoid impermissible hindsight. See MPEP § 2145, paragraph X.A. for a discussion of rebutting applicants' arguments that a rejection is based on hindsight.*

*"It is difficult but necessary that the decision maker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." W.L. Gore & Associates, Inc. v. Garlock,*



*Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983),  
*cert. denied*, 469 U.S. 851 (1984). {MPEP pg.2100-121}

The Applicant submits that the examiner has inadvertently applied *impermissible hindsight* in suggesting that Watanabe, Wilkinson and Hsiao in combination teaches the establishment of endowment fund to ensure the sustained financial viability of the archival of intellectual properties. In fact,

- Watanabe teaches assembly and distribution of a subset of IP for semiconductor design;
- Wilkinson teaches financial instruments based on IP; and
- Hsiao mentioned the unsuccessful attempt to establish an endowment to promote conference organization but had not provided any relevant no specific teaching nor that the endowment would be enduring.

None of these references teach any aspect of sustained archival of IP, let alone the establishment of endowment fund for each archived IP, nor provide a foundation for the preferred means of actuarial determination of endowment amounts or for preferred pooling of archival funds and mandated separate management, which are amongst Applicant's teachings.

Notably, the examiner's reference to an endowment at the top of page 4 of the office action: "where user fee and endowment are established to support the continued availability of the archived IP, and, by definition, an endowment fund is the fund provided for the continuing support and maintenance of the operation during the insufficiency of user fee", is clearly an application of impermissible hindsight by the examiner given the benefit of having current knowledge of Applicant's teaching. Applicant submits that this 'definition', however incomplete, is 'extracted' from the Applicant's teachings. It is not taught in any of the cited references, be it Watanabe, Wilkinson, or Hsiao. Neither has the examiner provided any reference to illustrate that it is somehow in the general knowledge of those with ordinary skills in the art.

By applying impermissible hindsight to the definition of 'endowment'; the examiner has in fact demonstrated clearly that no applicable prior art has been found.

**6. MPEP 2144.09:**

***PRIMA FACIE CASE REBUTTABLE BY EVIDENCE  
OF SUPERIOR OR UNEXPECTED RESULTS***

*A prima facie case of obviousness based on structural similarity is rebuttable by proof that the claimed compounds possess unexpectedly advantageous or superior properties. In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) {MPEP pg. 2100-158}*

The financial longevity of an endowment fund supported IP archive is a beneficial result unexpected by Watanabe, Wilkinson and Hsiao, separately or in combination.

**5. Conclusion**

The applicant respectfully submits that, in light of the above, and absent specific rebuttal of Applicant's points raised above, an obviousness rejection cannot be maintained.

Claim 3 should be in condition for allowance. Accordingly, claims 2, 9-13 and 19-32 should also be in condition for allowance as being dependent upon an allowable claim. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

In view of the foregoing remarks, reconsideration and allowance of claims 3, 2 9-13 and new claims 19 – 32 is respectfully requested.

If there are any outstanding issues that can be dealt with in a teleconference, this agent invites such a teleconference with the Examiner. This agent can be contacted at (403) 203-0107 (**Mountain Standard Time, - 2 hours**).

Respectfully submitted,

Date: Dec 21/05

  
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**Appendix A:**  
**Excerpts of Prior Art**  
**cited by the Examiner in Claim #3 Rejection**

**Watanabe, Wilkinson and Hsiao** are cited in the office action dated October 3, 2005 as prior art forming the basis for an U.S.C. 103 (a) rejection of Applicant's Claim #3.

The following excerpts are provided to assist the reader and demonstrate the prior art's teachings, which in Applicant's opinion, are very limited and largely not applicable to the applicant's claimed invention of 'assured and enduring archival of Intellectual property'.

To facilitate examination of these three repeatedly cited prior arts, the abstract and the cited sections of Watanabe, Wilkinson and Hsiao, respectively, are excerpted and reproduced herein below:

**1. Watanabe Patent**

U.S. Patent, Issued, #6,157,947

"Methods, Apparatus, System, and Program Storage Devices for Distributing Intellectual Properties"

**Abstract**

'A distribution apparatus is used to distribute *intellectual property to be reused for semiconductor product designing*. The distribution apparatus has a memory portion for registering intellectual property, users, and services available for the users, a processing portion for providing a user with a service allowed for the user, and a communication portion for automatically distributing the intellectual property. The distribution apparatus enables users to receive information about the intellectual property on time and to optimally share the intellectual property.'

*{Italics are applicant's emphasis}*

**Cited teaching: Col. 6, lines 39-67 & Figs. 6-7B**

"A server-client process will be explained with reference to FIG. 6.

In step S11, the manager 240 registers control information and user information in the server 210. Namely, the manager 240 registers server control data such as a server name, the necessity of approval when disclosing data, data transfer timing, data retention period, a manager name, a group name, user names, and services provided. In steps S12, S13, and

S14, a user 250 refers to the registered data when registering and retrieving a piece of intellectual property from and through the server 210.

If approved, the user 250 may change a password and the disclosure extent of an intellectual property piece stored in the server 210. The user 250 may register, update, delete, retrieve, refer to, and extract an intellectual property piece from and through the server 210.

FIGS. 7A and 7B show an example of a display screen used when registering, updating, and deleting an intellectual property piece and changing the disclosure extent of an intellectual property piece in the system of the present invention.

FIGS. 8A, 8B, and 8C show an example of a display screen used when retrieving, registering, updating, and deleting intellectual property and changing the disclosure extent of intellectual property.

The examples of FIGS. 7A to 8C handle intellectual property related to MPEG2 and SPARC (registered trade mark)."

Cited teaching: Col. 15, lines 24-39 & Figure 15

'FIG. 15 is a diagram for explaining an example of a comparison displaying process carried out in the system of the present invention.

In the distribution system, step S1 registers IP information (intellectual property), and step S2 maintains retrieval information (catalog retrieval data) from the IP information. Step S3 analyzes (categorizes) the IP information in accordance with the catalog retrieval data, and step S4 maintains the catalog database. Step S5 retrieves a necessary piece of intellectual property according to a retrieval condition input by the user (S401) and displays the result for the user. Step S6 registers comparing item information according to comparing items input by the user (S402), and step S7 displays the compared results (IP catalog) with indicating to the user (S403).'

U.S. Patent

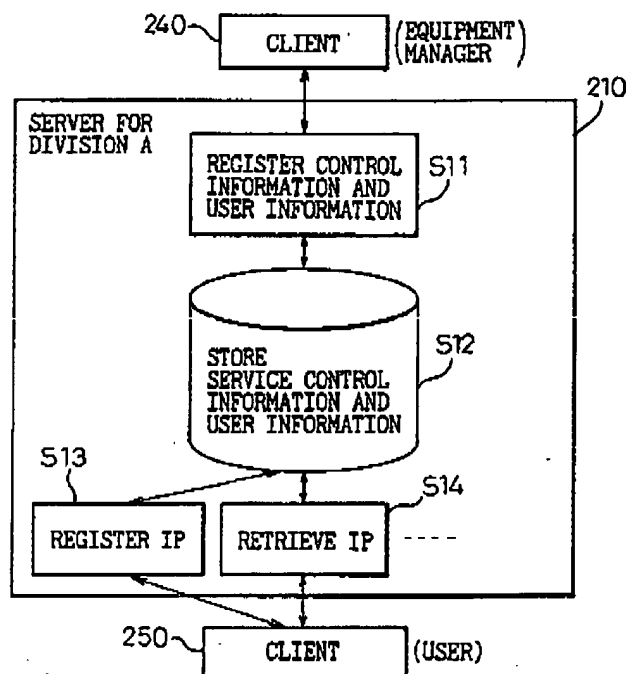
Dec. 5, 2000

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COPY

Fig. 6



SERIAL NO. 09/864,038

28

File : 2157-001 (old)

U.S. Patent

Dec. 5, 2000

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6,157,947

Fig. 7A

\*L1

**COPY**

IN SERVER: DIVISION XX  
REGISTRATION AND UPDATE SERVICE

-NARROWING KEY	No. FUNCTION IP NAME REGISTERED BY
-COMPANY NAME	
-FUNCTION (LARGE)	
-FUNCTION (SMALL)	
-REGISTRATION DATE	
-CORRESPONDING Tech.	
-DISCLOSURE EXTENT	
-IP NAME	
-IP No.	
-REGISTRATION DATE	
-DIVISION NAME	
-OPERATION FREQUENCY	

NARROWUndoUPDATENEWDELETEBack

DO YOU REALLY WANT TO DELETE?

YesNo

\*L1

SERIAL NO. 09/864,038

29

File : 2157-001 (old)

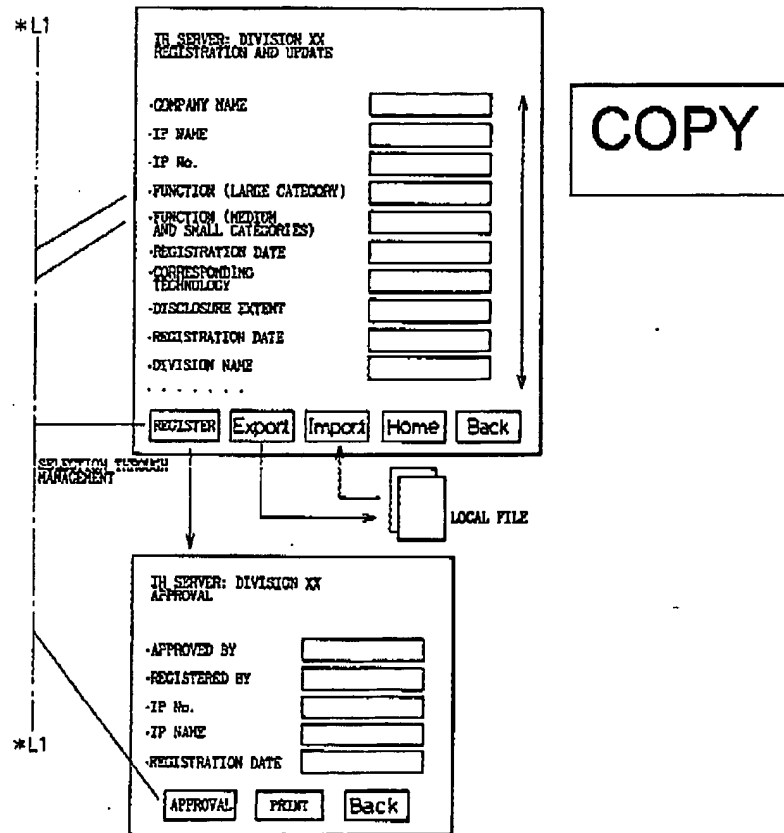
U.S. Patent

Dec. 5, 2000

Sheet 8 of 28

6,157,947

Fig. 7B

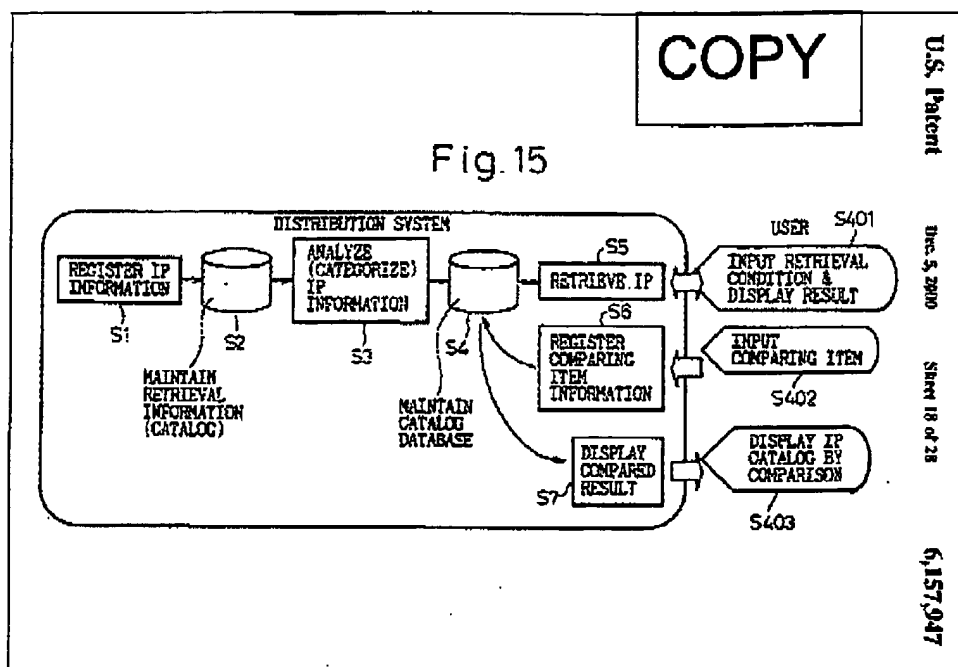


SERIAL NO. 09/864,038

30

File : 2157-001 (old)





## 2. Wilkinson Application

U.S. Patent Application, Publication #2001/0034695 A1  
 "Intellectual Property Financial Markets Methods and Systems"

### Abstract

'A method and system for facilitating *tangible valuation* of intellectual property assets. The method comprises providing a centralized intellectual property market accessible to others in which one or more *financial instruments*, each instrument representing an interest in at least one intellectual property asset, may be exchanged in one or more transactions for a tangible value. The market may comprise means for accepting bids from one or more first parties interested in acquiring one or more *financial instruments*, means for accepting asking positions from one or more second parties interested in receiving value in exchange for the one or more *financial instruments*, and means for matching the bids and asking positions and facilitating transactions between the first and second parties. The market enables methods for acquiring and selling shares in intellectual property assets, for computing the value of business entities by taking into account the value of intellectual property assets owned by the entities, and for creating mutual funds based upon shares in intellectual property assets.'

*{Italics are applicant's emphasis}*

Cited teaching: Page 3, [0023], [0024] [0025] and Page 4 [0035]

Page 3, [0023]

'The IP market may be regulated or supervised by a corresponding federal agency, such as the Securities and Exchange Commission (SEC), much in the same way that the SEC regulates the trading of stocks. The SEC or other analogous body may require registration of the financial instruments with that body before the instruments can be listed on the exchange, may enforce a set of rules for regulating the market and the people qualified to conduct business on the exchange, and *may assess fees or taxes, such as transaction fees or listing fees, to fund the regulatory process.*'  
{*Italics are applicant's emphasis*}

Page 3, [0024]

[0024] The IP market of this invention provides an independent valuation/appraisal method and service that periodically calculates and tracks the *desired value of a particular intellectual property asset*, much in the same way that stock markets set the market capitalization of corporations. The term "IP exchange value" as used herein refers to the value of a particular intellectual property asset or group of assets as determined by the market forces of the IP market, and refers to whatever value (such as fair market value, collateral value, and the like as noted elsewhere herein) that is the subject of the particular market on which the financial instruments representative of the financial interest in the assets are listed. The IP exchange value for a particular asset *may be computed as the value of a single unit of a financial instrument representative of an interest in the asset* multiplied by the number of units of the financial instrument issued. For example, where the financial unit is a share of equity (a stock), the value is the number of shares multiplied by the share price. Where only a portion of an asset is represented by issued financial instruments, the value of the entire asset is proportional to the value of the portion of the asset as valued via the IP market. The IP market automatically takes into account changing economic/political factors and/or changes in currency values of the country or countries in which the IP asset is enforceable. Use of the IP market further enables the adjustment and revaluation of the assets and balance sheets of business organizations, to account for the tangible values of intellectual property assets, as set by the market.  
{*Italics are applicant's emphasis*}

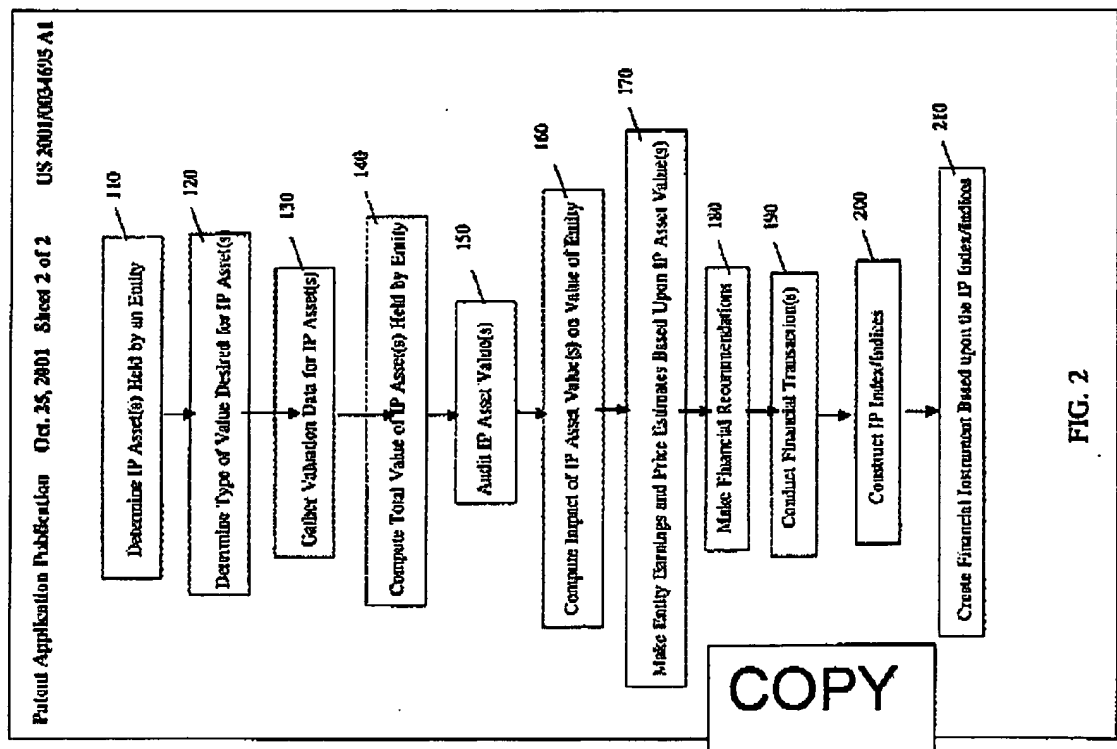
Page 3, [0025]

'Thus, the valuation method of using IP market may comprise *computing the value in part or in whole of any business entity for any purpose by taking into account the tangible market value of IP assets*. A business entity may be any business organization or part thereof, such as a partnership, fund, corporation, *trust*, foundation, *endowment*, sole proprietorship, association,

and the like. The purpose of determining the value may include for use as a basis for any financial transaction or for any business or financial purpose, including, for taxation, preparation of financial statements, debt/equity transactions, purchases, sales, loans, collateral, donations, exchanges, investing, trading, mergers, acquisitions, spin-offs, liquidation, buybacks, leveraged buyouts, stock/debt exchanges, hedge funds, and the like. The IP exchange value may also be used to determine the value of organizations with business assets for the purpose of reorganization, refinancing, liquidation, and the like during bankruptcy proceedings.  
*{Italics are applicant's emphasis}*

**Page 4, [0035]**

"The method of this invention may further comprise, as indicated by step 200 in FIG. 2, *constructing (gathering data and computing) an IP Index or indices* composed of individual IP assets, IP-impacted securities, or entities holding IP assets for the purpose of investment, comparison, and performance evaluation purposes. In this way, financial instruments related to IP assets or entities holding IP assets may be tracked against the performance of other IP assets or entities holding IP assets. The index may be used as a basis to compare investments, select investments, or a combination thereof."  
*{Italics are applicant's emphasis}*



### 3. Hsiao Article

Published Article.

"Will the Real VLDB Conference Please Stand Up?"

Pages 8-14, ACM SIGMOD Record, Vol. 12, issue 3, April 1982.

#### Excerpts from the Introduction (Page 1):

" ...

(1) Why do we suddenly have two VLDB (Very Large Data Bases) conferences this year?

(2) What are the differences between these two conferences?

(3) Are these two conferences related to the past VLDB conferences ... I shall attempted to give you a report regarding the issue and the answer to aforementioned questions. ..."

#### [Cited teaching: Page 11

"... It was at this time that we were suggested, especially by our Canadian colleagues, that we should formalize our efforts and set up a foundation for the seed money to promote VLDB Conferences and activities.

A year later the VLDB *Endowment* was formed under the laws of the State of Ohio and qualified it pursuant to the Internal Revenue Code Section 501(c)(3), as a not-for-profit organization for the promotion of international exchange on database research and development. ...."

*{Underlining are examiner's underlined emphasis.}*

*{Italics are applicant's emphasis.}*

## **Appendix B:** **Partial excerpts of Applicant's application**

The following excerpts from Applicant's specification and abstract are provided herein for convenience only. The excerpts include those with related to preferred embodiments and are not intended to be limiting.

**THE EXCERPTS MAY INCLUDE ELEMENTS OR FEATURES WHICH ARE NOT FEATURES REQUIRED TO DISTINGUISH THE PRESENT INVENTION, AS CLAIMED IN CLAIM 3 FROM THE PRIOR ART.**

The selected excerpts are merely illustrative for ease of reference to embodiments of the invention, and that they are not intended to be complete and may not be complete.

### **1. Applicant's Application**

U.S. Patent Application, Publication #2002/0178015 A1

"Method for the Assured and Enduring Archival of Intellectual Property"

*(as amended on June 24, 2005 from "Methods and Systems for Archiving, Indexing and Amending of Intellectual Property")*

### **2. Abstract**

Abstract *(as amended on June 24, 2005)*

"A technical and commercial method of managing information is provided including an *endowment fund associated with each of the plurality of information or intellectual property (IP) to be archived. The endowment fund assures the maintenance and storage of the archived IP.* Further, the endowment fund is managed separately from the user fees to ensure its enduring integrity and long term viability, with the user fees being applicable to user's access to the IP through an electronic communications network. Endowment funds for archived IP can be pooled for increased permanence. User's access to the archived IP can be managed including assignment of an access level and a cost for access. Users can access and amend a value-added access file associated with, yet separate from, the archived IP." *{Italics are applicant's emphasis}*

### **3. Claim 3**

Claim #3, the independent claim *(as amended on June 24, 2005)*

'A technical and commercial method of managing information comprising the steps of:

providing an information storage and retrieval archival system containing *plural archived intellectual property (IP)*;

enabling a user fee based access to the archived IP in the information storage and retrieval system by users through an electronic communications network , the user fees being insufficient to assure continued availability of the archived IP in the information storage and retrieval archival system; and

*establishing an endowment fund associated with the archived IP, said endowment trust being managed separately from the user fee based access, the endowment fund generating enduring funding for the maintenance and operation of the storage and retrieval archival system to assure continued availability of the archived IP regardless whether there is user fee based access thereto.'*

Claim #3, the independent claim (as currently amended)

'A technical and commercial method of managing information comprising the steps of:

providing an information storage and retrieval archival system containing plural archived intellectual property (IP);

enabling a user fee based access to the archived IP in the information storage and retrieval system by users through an electronic communications network , the user fees being insufficient to assure continued availability of the archived IP in the information storage and retrieval archival system; and

establishing an endowment fund associated with each archived IP, said endowment trust being managed separately from the user fee based access, the endowment fund generating enduring funding for the maintenance and operation of the storage and retrieval archival system to assure continued availability of the archived IP regardless whether there is user fee based access thereto.'

Claim #24, the claim on 'Access File'(previously amended)

The method of claim 19 further comprising the steps of:

establishing one or more access files separate from the archived IP, each access file associated with a user;

enabling access to an access file by a user wherein each access file comprises the PIPA for the archived IP, an identity of the user, and value-added information by the user.

4. Partial excerpts of Definitions of Intellectual Property (IP)

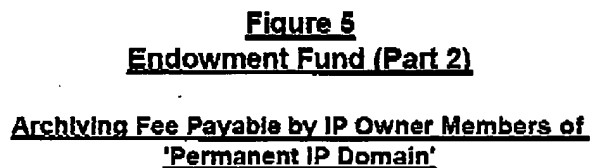
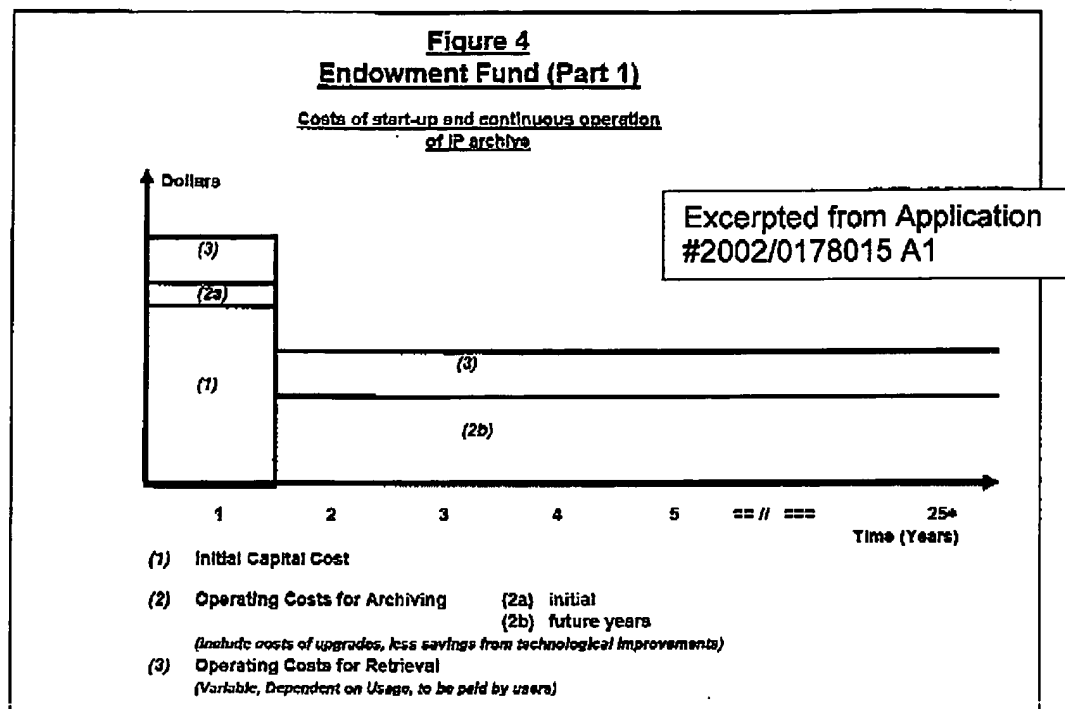
**related to Claim #3 excerpted from Zee Application #2002/0178015 A1**

*"[0004] Intellectual property (IP) such as books, journals, magazines and newspapers entail high capital and operating costs for physical preparation and handling. ... The use of the Internet or World Wide Web (I/WWW) to retail IP, such as books, journals, magazines, music compact discs (CD) and digital video discs (DVD), greatly increases the accessibility of these forms of IP."*

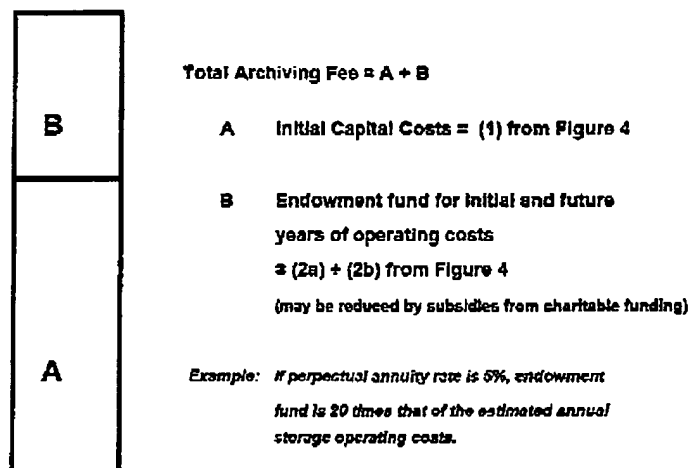
*"[0019] Printed articles and its readers are used in the description below as an example, but the present invention applies to all IP, including but not limited to those in the forms of written words, graphics, audio, visual, video, multi-media, and I/WWW content. Users of the IP described here include but are not limited to readers, viewers, and listeners."*

**5. Partial excerpts related to**  
**Endowment Fund enabled Permanent IP Archive as related to Claim #3**  
**(Figures 4 & 5 as amended on Jan 15, 2004):**

*"[0033] One key distinguishing and vital feature is the 'permanent nature' of the archive of IP in the Permanent IP Domain. This Permanence is achieved by the establishment of an a small endowment fund, associated with each IP, that will generate a perpetual stream of annuity payments (similar to 'life annuity payments' in life insurance industry or perpetual scholarships enabled by an endowment fund), defined through actuary determination and include allowance for contingencies, that will fund and sustain the physical operations associated with the ongoing archiving of each IP. Specifically, the fee paid by an IP owner to archive a specific IP will be set such that a portion of it can be placed into a separate "pool" of trustee managed "archiving endowment trust" that is designed to generate perpetual annuity payments to pay for future depreciation and operating costs associated with the 'archiving' of that IP. (Figures (Figs. 4 & 5). The operating costs associated with the retrievals will be separately born by users of the IP and charitable or commercial sponsors.) The separation of the trustee-managers of the "endowment trust" from the operators-managers of the Permanent IP Domain is a key design and operating element that will insulate the archive operation from the economic or policy fluctuations and changes of the commercial operation that may endanger the archiving operation's permanence. This archiving endowment trust may be further augmented, when possible, by donations, grants and allocation of a portion of operating surplus"*



Excerpted from Application  
#2002/0178015 A1





"[0034] This separate trustee managed financial structure that provides the function of permanence to the storage or archiving of IP, has never been explicitly defined, set-up and publicized by any other person or organization in the public domain. There may however have been some implied or implicit arrangements set up by governments, businesses or other organizations, used for internal undisclosed or private applications."

"[0035] Another distinguishing and vital feature is the accessibility by large number of individual IP owners to this 'pool enabled' function of 'permanent archive'. Similar to the establishment of insurance policy coverage, the benefit to individual participant is possible upon the establishment of a large pool of resources and associated risks, with the liquidity increasing and risk profile diminishing with the growth of the participating population. All IP owners joining as members of the Permanent IP Domain will benefit from this function of Permanent Storage. This mode of operation is novel and distinct from any other permanent storage arrangement used to date by individuals or organizations including businesses and government agencies, implied or otherwise."

"[0049] The fact that IP archived in this Permanent IP Domain has assured accessibility, plus the functionality of the "Access Files", allow most 'reference users' of IP to avoid keeping physical copies of these IP in the user's possession. These copies are in various forms, including but not limited to: books, journal, magazines, newspaper, photocopy, photograph, audio tape, video tape, laser disc, compact disc, video compact disc, digital video disc, mini-disc, floppy disc, zip drive disk, compact flash card, smart media card, memory stick, hard disc space and computer tapes. Significant savings will result from not needing to physically provide for the space, furniture, maintenance associated with these physical storage media. These costs savings will easily justify the small fees associated with the use of Permanent IP Domain and the Access Files."

**4. Partial excerpts related to Access Files as related to Claim #24  
excerpted from Application #2002/0178015 A1  
(Figures 4 & 5 as amended on Jan 15, 2004):**

[0039] (B) Access File

[0040] The present invention methods include the creation of a small and efficient "Access File" enabling users to reference and work with each IP stored. Each Access File contains the unique permanent IP Identification Address (PIPA) for the IP of interest, plus additional information such as user's identity and user-defined key words. It also contains value added information such as annotations, highlights, bookmarks, attachments, etc

applicable to the IP, (which may be a 300-page research report), but is a small and efficient file because it does not have to contain the sizable IP itself. (FIG. 6)

[0041] This Access File, with its unique Access File Identification Code (AFIC), can be stored in user's folders and/or be emailed to a recipient. It is itself now a new secondary class of Intellectual Property.

[0042] The Access File, whenever opened, will access the specific referenced IP in the Permanent IP Domain and apply all the value-added information to it, before presenting the combined product to the user. This Access File can be added to and modified by another user, and becomes another new Access File with a new Access File Identification Code, and so on. A generation code component will be included in the AFIC to indicated the number of generations of added value that have been added to the Access File.

**Figure 6**  
**Access File Attributes**

Public Information	Access File Identification Code	
	Access File Name	<input type="text"/>
	Comments	<input type="text"/>
	Access File Size	<input type="text"/>
	Access File Generation	<input type="text"/>
	Permanent IP Address	<input type="text"/>
	IP Name	<input type="text"/>
	IP Type	<input type="text"/>
	IP Size	<input type="text"/>
	Level of Access	<input type="text"/>
	Folders Linked	<input type="text"/> <input checked="" type="checkbox"/>
	# of annotations	<input type="text"/>
# of attached files	<input type="text"/>	
Private Information	User ID	<input type="text"/>
	User Defined Keywords	<input type="text"/> <input checked="" type="checkbox"/>
	Fee Paid	<input type="text"/>
	Purchase Date	<input type="text"/>
	Date of Last Access	<input type="text"/> <input checked="" type="checkbox"/>
<input type="button" value="OK"/> <input type="button" value="CANCEL"/> <input type="button" value="HELP"/>		

Excerpted from Application  
#2002/0178015 A1

\*\* Note: Information included by the user. All other information is filed in by the system.